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EXAMINER	
MAURO JR, THOMAS J	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/656,418	IWAYAMA ET AL.	
	Examiner	Art Unit	
	Thomas J. Mauro Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on August 30, 2004. In it claims 1-28 remain pending and are again presented for examination. Claims 29-30 are newly added. A formal action on the merits of claims 1-30 follows.

2. 112 2nd paragraph rejection and claim objections have been obviated in light of the amendments made in the amendment filed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863) in view of Liu et al. (U.S. 6,349,096), Goertzel et al. (U.S. 6,208,952) and Riddle (U.S. 5,854,898).

Regarding claim 1, Adamson teaches the invention substantially as claimed, a communication means notification method for use in a communications system selectively

employing communications means installed in information terminals on a network for users to communicate with one another, the method:

storing types communication methods operable by users information terminals **[Adamson -- Figure 3, Figure 6, Col. 5 lines 41-47 and Col. 6 lines 14-16 – User stores information, i.e. Name, Company, Address, and connection information and addresses]**; and

receiving a destination-user designation from a source user requesting communication **[Adamson -- Figure 9, Col. 6 lines 16-19 and Col. 7 lines 62-64 – User selects person whom he/she wishes to communicate with]**;

Adamson fails to teach generating and presenting a list of application layer communication means operable at both source and destination users terminals.

Goertzel, however, discloses a delayed system for registering a protocol for communication upon which a list of protocols supported by both the client and server remote procedure call sub-system (RPCS) is negotiated **[Goertzel -- Col. 3 lines 25-44 and Col. 7 lines 35-42]**.

In addition, Liu discloses a system wherein a user is presented with a list of communication types, i.e. WAN or PSTN, upon which the user can choose which communication method to use based upon certain criteria, i.e. connection speed, cost, etc **[Liu -- Col. 3 lines 44-55 and Col. 7 lines 4-12]**.

Furthermore, Riddle discloses a system for exchanging application level system capabilities between users wishing to join a conference as a participant **[Riddle -- Col. 3 lines 23-25, Col. 7 lines 33-67 – Col. 8 lines 1-26, Col. 10 lines 26-34]**.

Adamson, Goertzel, Liu and Riddle are concerned with methods to enable and establish communications with another entity, i.e. server or another client based upon capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the negotiation of a list of protocols supported by both a client and a server, as taught by Goertzel, along with the presenting of a list to the client of communication types, as taught by Liu and furthermore the negotiating of application layer client capabilities, as taught by Riddle, into the invention of Adamson, in order to provide maximum communication ability by providing multiple channels over which communications can occur which also provides a level of fault-tolerance in case one channel fails, to provide the user with flexibility to be able to choose the communication means that the user wants to use and finally to allow the best possible connection by allowing client applications to negotiate capabilities to provide the best/desired connection.

Regarding claim 2, Adamson teaches the invention substantially as claimed, comprising:

a first table storing for each user types of communication methods operable by users information terminals **[Adamson -- Col. 6 lines 63-67 – Data, including the connection types, are stored in a data structure, i.e. table, database, list, etc...]**;

an administration unit for receiving operable communication methods settings from users and storing the settings in said first table **[Adamson -- Col. 6 lines 12-16 – Allows for creating and editing of biz cards which include, connection settings]**; and

a designation unit for receiving destination user designations from source users requesting communication **[Adamson -- Figure 9, Col. 6 lines 16-19 and Col. 7 lines 62-64 – User selects person whom he/she wishes to communicate with]**.

Adamson fails to teach generating and presenting a list of application layer communication means operable at both source and destination users terminals.

Goertzel, however, discloses a delayed system for registering a protocol for communication upon which a list of protocols supported by both the client and server remote procedure call sub-system (RPCS) is negotiated **[Goertzel -- Col. 3 lines 25-44 and Col. 7 lines 35-42]**.

In addition, Liu discloses a system wherein a user is presented with a list of communication types, i.e. WAN or PSTN, upon which the user can choose which communication method to use based upon certain criteria, i.e. connection speed, cost, etc **[Liu -- Col. 3 lines 44-55 and Col. 7 lines 4-12]**.

Furthermore, Riddle discloses a system for exchanging application level system capabilities between users wishing to join a conference as a participant **[Riddle -- Col. 3 lines 23-25, Col. 7 lines 33-67 – Col. 8 lines 1-26, Col. 10 lines 26-34]**.

Adamson, Goertzel, Liu and Riddle are concerned with methods to enable and establish communications with another entity, i.e. server or another client based upon capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the negotiation of a list of protocols supported by both a client and a server, as taught by Goertzel, along with the presenting of a list to the client of communication types, as taught by Liu and furthermore the negotiating of application layer client capabilities, as taught by Riddle, into the invention of Adamson, in order to provide maximum communication ability by providing multiple channels over which communications can occur which also provides a level of fault-tolerance in case one channel fails, to provide the user with flexibility to be able to choose the communication means that the user wants to use and finally to allow the best possible connection by allowing client applications to negotiate capabilities to provide the best/desired connection.

Regarding claim 11, Adamson teaches the invention substantially as claimed, a computer-readable recording medium whereon is recorded a communication means notification program for use in information terminals **[Adamson -- Col. 5 lines 63-67 – Col. 6 lines 1-7 – System application is implemented using an objection oriented programming language, i.e. code and instructions obviously stored on a medium which are executed to run the system]**; said communication means notification program recorded on the computer-readable recording medium for executing the following steps:

preparing a first table storing for each user types of communication methods operable by user's information terminals **[Adamson -- Col. 6 lines 63-67 – Data structure, i.e. table, must be set up before storing data]**;

receiving operable communication methods settings from users and storing the settings in said first table **[Adamson -- Figure 3, Figure 6, Col. 5 lines 41-47 and Col. 6 lines 14-16 – User stores information, i.e. Name, Company, Address, and connection information and addresses]**; and

receiving destination user designations from source users requesting communication **[Adamson -- Figure 9, Col. 6 lines 16-19 and Col. 7 lines 62-64 – User selects person whom he/she wishes to communicate with]**;

Adamson fails to teach acquiring, generating and presenting a list of application layer communication means operable at both source and destination users terminals.

Furthermore, Riddle discloses a system for exchanging application level system capabilities between users wishing to join a conference as a participant **[Riddle -- Col. 3 lines 23-25, Col. 7 lines 33-67 – Col. 8 lines 1-26, Col. 10 lines 26-34]**.

Adamson, Goertzel, Liu and Riddle are concerned with methods to enable and establish communications with another entity, i.e. server or another client based upon capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the negotiation of a list of protocols supported by both a client and a server, as taught by Goertzel, along with the presenting of a list to the client of communication types, as taught by Liu and furthermore the negotiating of application layer client capabilities, as taught by Riddle, into the invention of Adamson, in order to provide maximum communication

ability by providing multiple channels over which communications can occur which also provides a level of fault-tolerance in case one channel fails, to provide the user with flexibility to be able to choose the communication means that the user wants to use and finally to allow the best possible connection by allowing client applications to negotiate capabilities to provide the best/desired connection.

Regarding claim 29, Adamson-Goertzel-Liu-Riddle teach the invention substantially as claimed, as aforementioned in claim 1 above, including wherein the application-layer communication methods includes chat **[Riddle -- Col. 12 lines 15-25 - Chat]**. Although instant messaging is not explicitly taught, it is very closely related to chat and therefore it would have been obvious to a person of ordinary skill in the art to implement such a system with instant messaging in order to provide a more direct and privatized conference, i.e. chat, with another participant.

Regarding claim 30, this is a method claim claiming limitations, which although written slightly different, are similar to that of claim 1 above. Therefore, claim 30 is rejected under the same rationale.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096) and Riddle (U.S.

5,854,898), as applied to claim 2, in view of Pickering (U.S. 6,076,093) and further in view of Cloutier (US 2001/0055963).

Regarding claim 3, Adamson-Goertzel-Liu-Riddle teach the invention substantially as claimed, as aforementioned in claim 2 above, but fails to teach the limitations of claim 3. Pickering, however, teaches these limitations substantially as claimed, the system further comprising: a second table for storing relationally to users and predetermined user statuses communication means actually usable in the user statuses **[Pickering -- Figure 2 and Col. 4 lines 4-5 – Table stores user names, methods of communication and status]**; wherein said first table together stores user status in addition to communication means **[Pickering -- Figure 2 and Col. 4 lines 4-5]**, and said administration means receives settings on new user status and writes actually usable communication means in the new user status into said first table in accordance with said second table settings **[Pickering -- Col. 5 lines 38-65 – Status information and communications means can be updated in a variety of ways]**.

Further, Cloutier, teaches a prioritizing means for receiving settings on the actually usable communication means in the predetermined user statuses and storing the settings in said table **[Cloutier -- Page 1 paragraph [0008] - Priority is set between devices when multiple devices can be used for communication]**.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the storing and prioritizing of communication means and statuses as taught by Pickering and Cloutier into the invention of Adamson-Goertzel-Liu-Riddle in order to provide a mechanism which allows users to set precedence on which devices he/she wishes to

communicate with the most and to determine the availability/status of users and the communication means through which they can be reached.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096) and Riddle (U.S. 5,854,898), as applied to claim 2, in view of Minnick et al. (U.S. 6,370,381).

Regarding claim 4, Adamson-Goertzel-Liu-Riddle teaches the invention substantially as claimed, as aforementioned in claim 2 above, but fail to teach generating a list based on the priority level of the communication means.

Minnick, however, teaches generating a list based on the priority level of the communication means usable by both source and destination user **[Minnick -- Col. 4 lines 17-18 – Priority sorted list of communication devices]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include generating a priority sorted list of available communication devices, as taught by Minnick into the invention of Adamson-Goertzel-Liu-Riddle, in order to quickly determine the best communication device according to preferences which is currently available to use.

Regarding claim 5, Adamson-Goertzel-Liu-Riddle-Minnick teach the invention substantially as claimed, as aforementioned in claim 4 above, including a generation unit which

rearranges the communication methods in accordance with source user priority level **[Minnick -- Col. 4 lines 17-18 – Produces priority sorted list of communication devices]**.

Regarding claim 6, Adamson-Goertzel-Liu-Riddle-Minnick teach the invention substantially as claimed, as aforementioned in claim 4 above, but fails to explicitly teach a generation unit which rearranges communication methods in accordance with source user priority level. However, Adamson-Goertzel-Liu-Riddle-Minnick do suggest arranging a list based on priority of communication devices for the source user. It would have been obvious that arranging a list for a source user could have also been done for a plurality of users, including the destination user. Therefore, it would have been obvious that was a matter of design choice at the time the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096) and Riddle (U.S. 5,854,898), as applied to claim 2, in view of Lee (U.S. 6,475,089).

Regarding claim 10, Adamson-Goertzel-Liu-Riddle teach the invention substantially as claimed, as aforementioned in claim 2 above, but fails to teach wherein said communication method is a game application for a plurality of users.

Lee, however, teaches the invention substantially as claimed, wherein said communication means is a game application wherein a plurality of users can participate on a network **[Lee --**

Figure 1, Figure 7 and Col. 2 lines 10-30 – Users who wish to play opponents in a game over the network connect to host server to enroll].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the gaming application, as taught by Lee into the invention of Adamson-Goertzel-Liu-Riddle, in order to provide an application which relies heavily on establishing and maintaining connections between users.

8. Claims 12-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863) in view of Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096), Riddle (U.S. 5,854,898), Balasubramaniam et al. (U.S. 6,477,550) and Ansberry et al. (U.S. 5,715,392).

Regarding claim 12, Adamson teaches the invention substantially as claimed, the method comprising:

for each user storing types of communication methods operable by users' information terminals **[Adamson -- Figure 3, Figure 6, Col. 5 lines 41-47 and Col. 6 lines 14-16 – User stores information, i.e. Name, Company, Address, and connection information and addresses]**;

receiving a destination-user designation from a source user requesting communication **[Adamson -- Figure 9, Col. 6 lines 16-19 and Col. 7 lines 62-64 – User selects person whom he/she wishes to communicate with]**; and

Adamson, however, fails to teach generating and presenting a list of application layer communication means operable at both source and destination users terminals, generating a list to a terminal which contains the communications means not compatible with each other and a composite list of the communications means, and downloading and executing the communications means to a terminal.

Goertzel, however, discloses a delayed system for registering a protocol for communication upon which a list of protocols supported by both the client and server remote procedure call sub-system (RPCS) is negotiated **[Goertzel -- Col. 3 lines 25-44 and Col. 7 lines 35-42]**.

In addition, Liu discloses a system wherein a user is presented with a list of communication types, i.e. WAN or PSTN, upon which the user can choose which communication method to use based upon certain criteria, i.e. connection speed, cost, etc **[Liu -- Col. 3 lines 44-55 and Col. 7 lines 4-12]**.

Further, Ansberry teaches wherein matched types are removed from a list leaving the ones not compatible with one of the clients **[Ansberry -- Col. 4 lines 62-64]** and a composite list is generated **[Ansberry -- Col. 4 32-34 – list of all types supported]**.

Furthermore, Balasubramaniam teaches wherein software, i.e. plug-in, not present on the system, can be downloaded and executed on the system **[Balasubramaniam -- Col. 4 lines 17-27 and Col. 6 lines 44-54]**.

Finally, Riddle discloses a system for exchanging application level system capabilities between users wishing to join a conference as a participant **[Riddle -- Col. 3 lines 23-25, Col. 7 lines 33-67 – Col. 8 lines 1-26, Col. 10 lines 26-34]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the negotiation of a list of protocols supported by both a client and a server, as taught by Goertzel, the presenting of a list to the client of communication types, as taught by Liu, negotiating the application layer client capabilities, as taught by Riddle, the list generation capabilities for composite list and incompatible types, as taught by Ansberry, along with the downloading and execution of communication means, as taught by Balasubramaniam into the invention of Adamson, in order to provide maximum communication ability by providing multiple channels over which communications can occur which also provides a level of fault-tolerance in case one channel fails and to also provide the user with flexibility to be able to choose the communication means that the user wants to use. Further motivation allows the conference system to support those incompatible communications means that differ from those which they currently support so that a wider range of transports are supported and fewer communication errors occur and to overcome communication barriers caused by incompatible communications means in addition to allowing the best possible connection by allowing client applications to negotiate capabilities to provide the best/desired connection.

Regarding claim 13, Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam teach the invention substantially as claimed, as aforementioned in claim 12 above, including the communications means is downloadable and executable to the terminals **[Balasubramaniam --**

Col. 4 lines 17-27 and Col. 6 lines 44-54].

Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam fail to teach a list where the communication means is not present on either of the terminals.

Ansberry, however, teaches the invention substantially as claimed, wherein incompatible types of both terminals are categorized in a list **[Ansberry -- Col. 4 lines 65-67]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the list of incompatible types not present on either terminal, as taught by Ansberry into the invention of Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam, in order to allow the conference system to support those incompatible communications means that differ from those which they currently support so that a wider range of transports are supported and fewer communication errors occur.

Regarding claim 16, Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam teach the invention substantially as claimed, including a computer-readable recording medium whereon is recorded a program for executing the communication means notification method **[Adamson -- Col. 4 lines 17-18 – Application executes to perform program which must be stored in memory to run]**.

Regarding claim 17, this is a system claim corresponding to the method claimed in claim 12. It has similar limitations; therefore, claim 17 is rejected under the same rationale.

9. Claims 14-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863) in view of Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096), Riddle (U.S. 5,854,898), Balasubramaniam et al. (U.S. 6,477,550) and Ansberry et al. (U.S. 5,715,392), as applied to claims 12 and 17 above respectively, in view of Morris et al. (U.S. 6,496,851).

Regarding claim 14, Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam teach the invention substantially as claimed, as aforementioned in claim 12, but fail to teach download and execution conditions along with including the second list is generated based on terminal information and download conditions and execution conditions for users information terminals. Morris, however, teaches the invention substantially as claimed, wherein download conditions for downloading communication means to users information terminals and execution conditions for executing communication means on users information terminals are stored in advance for each downloadable communication means **[Morris -- Col. 10 lines 65-67 – Col. 11 lines 1-2 – No adverse conditions are present, i.e. error messages, therefore, none are stored]**. Furthermore, Ansberry teaches the a second list is for incompatible types on one of the clients, thus implicitly incorporating download conditions if any are present **[Ansberry -- Col. 4 lines 62-64]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the incompatible list, i.e. second list, as taught by Ansberry, along with download conditions, as taught by Morris into the invention of Adamson-Goertzel-Liu-Riddle-Ansberry-

Balasubramaniam, in order to provide a mechanism which validates the credibility of the downloads with which is incompatible with either the source or destination user before the download occurs.

Regarding claim 15, Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam-Morris teach the invention substantially but fails to teach selection of a communication means from a third list and downloading communication means if necessary.

Morris, however, teaches wherein selection of any of the communication means on the third list is received from the source user and the selected communication means is reported to the destination user's information terminal **[Morris -- Figure 3 and Col. 6 lines 42-67 - Col. 7 lines 1-30 and Col. 8 lines 1-17 – Destination user receives proposal from source user upon which he makes a selection which is then sent back to the originator, i.e. source]**; and if the destination user's information terminal does not have the selected communication means, the destination user's information terminal acquires the selected communication means by downloading **[Morris -- Col. 10 line 65-67 – User can download software in order to accept and participate in desired proposal]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the selection and downloading of communications means, as taught by Morris, into the invention of Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam-Morris, in order to provide users with a way of negotiating between mutually acceptable communication means.

Regarding claim 18, Adamson-Goertzel-Liu-Riddle-Ansberry-Balasubramaniam-Morris teach the invention substantially as claimed, a creation means for creating a downloadable executable list of communication means downloadable to information terminals and executable on the information terminals for destination users and source users respectively **[Morris -- Col. 10 lines 65-67 – In order for the downloads to be presented for downloading, it is required that the list would have been created by the program and therefore is implicitly provided]**; and a supply means for supplying communication means included in the downloadable-executable list to user information terminals **[Morris -- Col. 10 lines 65-67 – Col. 11 lines 1-8 – Download is presented, therefore, the list of program(s) were supplied to the user implicitly]**.

10. Claims 7, 9, 19-20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096) and Riddle (U.S. 5,854,898), as applied to claims 2 and 19 above respectively, in view of Pickering (U.S. 6,076,093)

Regarding claim 7, Adamson-Goertzel-Liu-Riddle teach the invention substantially as claimed, as aforementioned in claim 2, but fail to teach wherein said designation means receives designations using identification information designating operable communication means at destination users information terminals.

Pickering, however teaches the invention substantially as claimed, wherein said designation means receives designations using identification information designating operable communication means at destination users information terminals **[Pickering -- Col. 6 lines 59-63 – Internet telephone calls are made by clicking on the destination user's Internet phone number, i.e. identification information]**.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the use of designations from the identification information of the device, as taught by Pickering into the invention of Adamson-Goertzel-Liu-Riddle, in order to provide a fast and direct way of initiating communication with another user rather than having to select their name and then subsequently choose how they wish to connect to them.

Regarding claim 9, Adamson-Goertzel-Liu-Riddle-Pickering teach the invention substantially as claimed, wherein said designation means is enabled to receive a destination user's designation according to identification information specifying operable communication means at destination user's information terminals **[Pickering -- Col. 6 lines 59-62 – Internet telephone calls are made by clicking on the destination user's Internet phone number, i.e. identification information for communications device]**. Adamson-Goertzel-Liu-Riddle, however, fail to teach starting the communications session if both source and destination support the communications method.

Pickering, however, teaches this limitation substantially as claimed, selecting a communication means and starting the communications between source and destination **[Pickering -- Col. 6 lines 59-63 – After clicking on the destination user's identification information, i.e. Internet**

telephone number, the call is placed and a ringing icon is displayed on the destination user's desktop].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate starting the communications sessions between users if the communications device type is supported at both ends, as taught by Pickering into the invention of Adamson-Goertzel-Liu-Riddle, in order to provide a fast and simple way to start communications between two users which both support a device type.

Regarding claim 19, Adamson teaches the invention substantially as claimed, a communication means notification method for use in a communications system selectively employing communications means installed in information terminals on a network for users to communicate with one another, the method comprising:

for each user storing types of communication methods operable by users information terminals **[Adamson -- Figure 3, Figure 6, Col. 5 lines 41-47 and Col. 6 lines 14-16 – User stores information, i.e. Name, Company, Address, and connection information and addresses]**; and

receiving a destination-user designation from a source user requesting communication **[Adamson -- Figure 9, Col. 6 lines 16-19 and Col. 7 lines 62-64 – User selects person whom he/she wishes to communicate with]**;

Adamson fails to teach generating and presenting a list of application layer communication means operable at both source and destination users terminals and distinguishing between a plurality of the same type of connections and reporting the list to the source user.

Goertzel, however, discloses a delayed system for registering a protocol for communication upon which a list of protocols supported by both the client and server remote procedure call sub-system (RPCS) is negotiated **[Goertzel -- Col. 3 lines 25-44 and Col. 7 lines 35-42]**.

In addition, Liu discloses a system wherein a user is presented with a list of communication types, i.e. WAN or PSTN, upon which the user can choose which communication method to use based upon certain criteria, i.e. connection speed, cost, etc **[Liu -- Col. 3 lines 44-55 and Col. 7 lines 4-12]**.

Furthermore, Pickering teaches distinguishing between a plurality of the same type of connections **[Pickering -- Figure 2 – Plurality of phone numbers are distinguished by phone number and heading as to type of phone]** and reporting the list to source user **[Pickering -- Col. 2 lines 23-26]**.

Finally, Riddle discloses a system for exchanging application level system capabilities between users wishing to join a conference as a participant **[Riddle -- Col. 3 lines 23-25, Col. 7 lines 33-67 – Col. 8 lines 1-26, Col. 10 lines 26-34]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the negotiation of a list of protocols supported by both a client and a server, as taught by Goertzel, along with the presenting of a list to the client of communication types, as taught by Liu, the negotiating of application layer client capabilities, as taught by Riddle, and the ability to separate communication means of the same type, as taught by Pickering, into the invention of Adamson, in order to provide maximum communication ability by providing multiple channels over which communications can occur which also provides a level of fault-tolerance in case one channel fails and to also provide the user with flexibility to be able to

choose the communication means that the user wants to use. Further motivation would allow for the source user to be able to easily discern and distinguish between the different connections available and finally to allow the best possible connection by allowing client applications to negotiate capabilities to provide the best/desired connection.

Regarding claim 20, Adamson-Goertzel-Liu-Riddle-Pickering teach the invention as claimed, as aforementioned in claim 19 above, including user set messages with respect to communication means on information terminals are stored together with the communication means and information terminals **[Pickering -- Figure 2 and Col. 5 lines 35-37 – User can enter text in status information to inform other user's with more information regarding a particular communications means]**; and a destination user set message is further included in the list reported to the source user **[Pickering -- Col. 2 lines 23-26 – Table, as shown in Figure 2, is reported to source user with status information]**.

Regarding claim 27, Adamson-Goertzel-Liu-Riddle-Pickering teach the invention substantially as claimed, as aforementioned in claim 19 above, a computer-readable recording medium whereon is recorded a program for executing the communication means notification methods **[Adamson -- Col. 2 lines 16-20 – Application, i.e. program is contained, i.e. stored, on each PC in the conferencing system]**.

Regarding claim 28, this is a system claim corresponding to the method claimed in claim 19. It has similar limitations; therefore, claim 28 is rejected under the same rationale.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096) and Riddle (U.S. 5,854,898), as applied to claim 2 above, in view of what was well known in the art.

Regarding claim 8, Adamson-Goertzel-Liu-Riddle teach the invention substantially as claimed, as aforementioned in claim 2 above, but fails to teach the first item in the list generated is the same communication means used if both users can support that means. It would have been obvious that the source user would contact the destination user with a communication means supported on the terminal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place that communication means at the head of the list of supported communication devices which can be supported by both source user and destination user, as a matter of design choice.

12. Claims 21-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096), Riddle (U.S. 5,854,898) and Pickering (U.S. 6,076,093), as applied to claim 19 above, in view of Cloutier (U.S. 2001/0055963) and Minnick et al. (U.S. 6,370,381).

Regarding claim 21, Adamson-Goertzel-Liu-Riddle-Pickering teach the invention substantially as claimed, as aforementioned in claim 19, including the communication means operable at the same user's single information terminal or plurality of information terminals are grouped by predetermined criteria **[Cloutier -- Page 1 paragraph [0008] – Devices are grouped by setting the priority of each device, i.e. predetermined criteria]**; said list is generated based on the grouped communication means; and the communication means described in said list are grouped by the predetermined criteria, and reported to the source user before communication begins **[Minnick -- Col. 4 lines 17-18 – Priority sorted list of communication devices is reported]**. The same rationale is used to combine Cloutier and Minnick with Adamson-Goertzel-Liu-Riddle-Pickering as was applied above.

Regarding claim 22, Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick teach the invention substantially as claimed, as aforementioned in claim 21, wherein group priority rankings are established for the communication means **[Cloutier -- Page 1 paragraph [0008] – Devices are grouped by setting the priority of each device]**, and said list is created based on the priority rankings **[Minnick -- Col. 4 lines 17-18 – Priority sorted list of communication devices is reported]**.

Regarding claim 24, Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick teach the invention substantially as claimed, as aforementioned in claim 22 above, including a recommended communication means is established for each source user in each communication means group **[Cloutier -- Page 1 paragraph [0008] – Devices are grouped by setting the**

priority of each device, i.e. the preferred device is the recommended communication means]; and said list is generated by modifying the communication means priority ranking for each source **[Minnick -- Col. 4 lines 17-18 – Priority sorted list of communication devices is reported]**.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096), Riddle (U.S. 5,854,898), Pickering (U.S. 6,076,093), Cloutier (U.S. 2001/0055963) and Minnick et al. (U.S. 6,370,381), as applied to claim 22 above, and further in view of Avidan (U.S. 6,608,895).

Regarding claim 23, Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick teach the invention substantially as claimed, as aforementioned in claim 22 above, but fail to teach wherein said priority rankings are established based on sequence made by usability within the groups.

Avidan, however, teaches wherein said priority rankings are established based on sequence made by usability within the groups **[Avidan -- Col. 5 lines 54-59 and Col. 8 lines 10-11 – Ranking is based upon age since last usage, i.e. something used rarely becomes aged and drops to a lower ranking, i.e. priority, and something used frequently goes up in rank]**.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the priority ranking based upon past usability, as taught by Avidan into the

invention of Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick in order to provide a self-ranking system which presents to the user the most used connections at the top of the priority listing.

14. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamson et al. (U.S. 5,717,863), Goertzel et al. (U.S. 6,208,952), Liu et al. (U.S. 6,349,096), Riddle (U.S. 5,854,898), Pickering (U.S. 6,076,093), Cloutier (U.S. 2001/0055963) and Minnick et al. (U.S. 6,370,381), as applied to claim 21 above, and further in view of Morris et al. (U.S. 6,496,851).

Regarding claim 25, Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick teach the invention substantially as claimed, as aforementioned in claim 21 above, but fail to teach wherein a selection is made based on a list received from a source user and communication is attempted using that selection.

Morris, however, teaches wherein a selection is made based on a list received from a source user and communication is attempted using that selection **[Morris -- Figure 3 and Col. 48-56 – Proposal is sent from one user to another user upon which the destination user can select to accept, reject, or issue a counterproposal before communication is started using that means]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the proposal and selection of parameters, as taught by Morris into the invention of Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick, in order to provide a flexible negotiation mechanism in order to agree upon a mutually acceptable communications means.

Regarding claim 26, Adamson-Goertzel-Liu-Riddle-Pickering-Cloutier-Minnick-Morris teach the invention substantially as claimed, wherein selection of any group based on said list is received from the source user **[Morris -- Col. 3 lines 50-51 Proposal is sent to destination]**; inquiry is made to the destination user's communication means included in the selected group as to whether it is receiving or not **[Pickering -- Figure 2 and Col. 4 lines 53-54 – Real-time status of destination user's communication means]**; and communication begins with the communication means first to respond in the destination user's information terminal **[Pickering -- Col. 6 lines 59-63 – After clicking on the destination user's identification information, i.e. Internet telephone number, communication is started]**.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 571-272-3917. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJM
January 17, 2005

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Art Unit 2143
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